

#### **IV. REMARKS**

- **Status of Claims:**

**Amendments of the claims 1, 4, 8, 10-12 are made herein. Claims 2 and 3 have been cancelled, without prejudice. Claims 13-14 are newly added. Claims 1, and 4-14 are submitted for reexamination and reconsideration. No new matter is introduced with this amendment.**

- **Statement with Respect to Scope of Amended and Non-Amended Claims**

Revisions to the claim set is made in order to streamline prosecution of this case in order to obtain early allowance of embodiments that are presently anticipated to be of commercial significance and in response to the Examiner's restriction requirement which has been made final in the Office Action, and are not made for a purpose of patentability. Any amendment, cancellation, withdrawal or addition made herein with respect to the claims should not be construed in any manner as indicating Applicant's surrender of any subject matter of the application, or surrender of any equivalent to any element asserted in one or more claims. Any narrowing which may be evinced with respect to subject matter covered by the claims as a whole, or by one or more claims of the appended claims whether amended, re-represented, or new, when compared to claims previously in the application, should not be interpreted as indicating that the Applicant has generally disclaimed the territory between the original claimed subject matter and the amended claimed subject matter. Amended claims elements are to be construed to include substantial equivalents known to those of ordinary skill in the art. Applicant asserts that any amendments transacted herein are made without prejudice and reserve all rights to prosecute any canceled claims, and claim structures preceding any amendment to a particular claim, and other disclosed (but not presently claimed) embodiments in the application, in future continuation applications, divisional applications, continuation-in-part applications, continuing prosecution applications, requests for continuing examination, re-examination applications and

any other application claiming priority to the present application.

### ***Objections to the Drawings***

#### **The Examiner's Position:**

The drawings are objected to under 37 CFR 1.83(a). The Examiner contends that corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

#### **Applicant's Response:**

Applicant respectfully disagrees. No new drawing is deemed necessary in the response since the Fig. 1 is merely an illustration indicating the approximate IC card position or geography regarding the deformable optical data. In order to remove any ambiguity from the description, Applicant respectfully proposes entry of the amendment as set forth above wherein the 'stippled area' 7 illustration of Fig. 1 is merely indicating an approximate area of deformable or deformation-derived optical data instead of intending to show any actual "deformation" as objected to by the Examiner. Applicant requests withdrawal of the requirement of a new drawing in view of the presently amended description of area (7) in paragraph [0040] and [0043].

### ***Specification***

Applicant has replaced the rejected abstract with a new abstract as set forth above.

### ***Claim Objections***

Applicant has amended the claim appropriately to overcome Examiner's objection.

***Claim Rejections -35 USC § 102***

Claims 1-8, 11, and 12 are rejected under 35 U. S. C. 102(b) as being anticipated by Narusawa et al. (US 6,527,173) (hereinafter referred to as 'Narusawa').

In the Examiner's opinion, Narusawa teaches an IC card (crude card 26) and method for authenticating the IC card comprising a substrate, said substrate having a semiconductor integrated circuit (IC module 53) and one or more optical data deformations incorporated therein that are representative of digital data (col. 5, line 59 - col. 6, line 3).

***Claim Rejections -35 USC § 103***

Claims 9 and 10 are rejected under 35 U. S. C. 103(a) as being obvious over Narusawa in view of Setani (US 4,963,464).

The Examiner admits that the primary reference to Narusawa lacks the teaching of pits of two distinctly different depths. This deficiency has supposedly been remedied by the combination with the secondary reference to Setani's alleged IC card substrate wherein pits of the optical deformations have two distinctly different depths (see figures 5 and 8).

**Applicant's Response:**

Applicant respectfully traverses the rejections of the claims.. In the first instance, the cited reference to Narusawa does not disclose, claim or suggest the presently claimed invention. Applicant traverses the Examiner's 35 U.S.C. §102(b) rejections asserting in part that the references of record do not teach every element of any claim. Applicant respectfully notes that anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference, device, or practice (See, *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). Moreover, Applicant has amended the claims herein to streamline prosecution of the claims to embodiments of the invention which are

currently believed to be of commercial interest.

In particular, the cited primary reference to Narusawa neither describes nor suggests the pits /landing type deformation as claimed. The cited reference does not disclose deformable or deformation-derived optical data, such as any effect on the alleged holographic material by the cited metal layer, much less a controlled or predetermined deformation in the form of e.g. pits of varying depths that would affect reflective light intensity.

The Examiner therefore has relied on the secondary reference to Setani to overcome the deficiency of the primary reference. More specifically, in the opinion of the Examiner, one of ordinary skill in the art would have readily recognized that providing the invention of Narusawa with pits having two distinctly different depths would have been beneficial for increasing the amount of data incorporated into the card. Therefore, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the teachings of Narusawa with the aforementioned teaching of Setani to expand the card's storage capabilities.

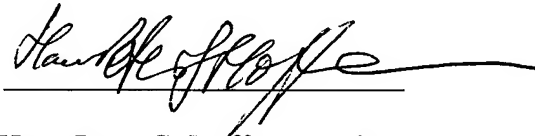
Applicant respectfully disagrees. In traverse, the Applicant asserts that the alleged combination of the references does not reasonably predict the presently claimed invention. First, the references taken alone or combined, do not disclose or suggest distinct transient optical state changes associated with deformable optical data as hacker preventatives. Moreover, none of the references even remotely suggests a timed reversion to an initial optical state from an altered secondary optical state. The references are silent as to the inventive use of a transient optical state change security material so as to achieve a barrier to illegal or inadvertent IC card access or use. Finally, the references are silent as to the secondary optical state reverting to an initial state. The references taken singly or combined do not remotely suggest a time related return of the latter state to the earlier state.

In view of this amendment and remarks set forth, the rejection of the claimed subject matter over the cited art is deemed moot. Therefore, withdrawal of the non-final rejection is solicited. No change of the named inventors is required.

### CONCLUSION

The application is now believed to be in condition for allowance and an early notification thereof is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Hans-Peter G. Hoffmann', written over a horizontal line.

Dated: September 28, 2005.

Hans-Peter G. Hoffmann, PhD  
Reg. No. 37,352  
KELLEY DRYE & WARREN LLP  
TWO STAMFORD PLAZA  
281 Tessler Blvd  
STAMFORD, CT 06901  
Telephone: 203-351-8011  
Facsimile: 203-327-2669  
e-mail: hhoffmann@kelleydrye.com